



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,994	08/09/2000	Howard Demehl	DERN-00101	5407

28960 7590 02/10/2004  
HAVERSTOCK & OWENS LLP  
162 NORTH WOLFE ROAD  
SUNNYVALE, CA 94086

EXAMINER
----------

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/635,994

Applicant(s)  
Dernehl Et La.,

Examiner  
John Young

Art Unit  
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 28, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*[Handwritten signature]*  
2-4-2004

Art Unit: 3622

## **THIRD ACTION REJECTION**

**(Paper#12)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103( a )**

**2. Rejections Maintained.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-49 are rejected under 35 U.S.C. §103( a ) as being obvious over Ng 6,405,175 (6/11/2002) [US f/d: 7/27/1999] (herein referred to as “Ng”) in view of Morton 6,327,572 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as “Morton”) and further in view of Capiel, US 6,449,634 (09/10/2002) [US f/d: 01/29/1999] (herein referred to as “Capiel”).

Art Unit: 3622

As per independent claim 1, Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) shows the elements and limitations of claim 1.

Ng lacks an explicit recitation of “offering a potential reward to a first party in exchange for promotional assistance of the first party, the promotional assistance comprising assistance in a forwarding of a first e-mail message to a second party, the first e-mail message comprising a personalized referral for the marketable entity, and a first set of data comprising a first serial number and a first URL link. . . .” even though Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) suggests same.

Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows “offering a potential reward to a first party in exchange for promotional assistance of the first party, the promotional assistance comprising assistance in a forwarding of a first e-mail message to a second party. . . .”

Morton proposed email forwarding modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Morton with the teachings of Ng because

Art Unit: 3622

such combination would have provided means for “*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . .*” (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Capiel (col. 12, ll. 53-61; and col. 13, ll. 10-25) discloses: “‘*sensor server program*’ with parameters ‘*E-mail address*’ and ‘*unique mail code*’. . . .” and “*member\_id int. . . .*”

Capiel (the ABSTRACT; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 1; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows “e-mail message comprising a personalized referral for the marketable entity, and a first set of data comprising a first serial number and a first URL link. . . .”

Capiel (col. 1, ll. 55-60) shows elements that suggest tracking the email recipient’s movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

Capiel proposes email and URL forwarding modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Capiel with the teachings of Ng because such combination would have provided means for “*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . . .*” (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a “viral marketing system in connection

Art Unit: 3622

with an information service. . . .” (See Morton (col. 10, ll. 12-20)) and because such combination would have provided a means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per claims 2-45, Ng in view of Morton and further in view of Capiel shows the method of claim 1 and subsequent claims depending from claim 1. (See the rejection of claim 1 supra).

Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) shows elements that suggest the elements and limitations of claims 2-45.

Ng lacks an explicit recitation of the elements and limitations of claims 2-45, even though Ng suggests same; however,

Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) in view of Capiel (the ABSTRACT; col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 1; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that reasonably suggest the elements and limitations of claims 2-45.

Art Unit: 3622

Morton in view of Capiel propose email, reward and URL link modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Morton with the teachings of Ng because such combination would have provided means for “*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . .*” (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a “viral marketing system in connection with an information service. . .” (See Morton (col. 10, ll. 12-20)) and because such combination would have provided a means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

As per independent claim 46, Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) shows the elements and limitations of claim 1.

Ng lacks an explicit recitation of “offering a reward to a first party to assist in recommending a second marketable entity substantially similar to the first marketable entity to a second party wherein the recommendation results in a transaction . . . forwarding an e-mail to a second party, the e-mail message comprising a recommendation for the second marketable entity and a URL link to a Web site. . .” even though Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col.

Art Unit: 3622

4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) suggests same.

Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows “offering a reward to a first party to assist in recommending a second marketable entity substantially similar to the first marketable entity to a second party wherein the recommendation results in a transaction. . . .”

Morton proposed reward modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Morton with the teachings of Ng because such combination would have provided means for “*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . . .*” (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Capiel (the ABSTRACT; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 1; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows “forwarding an e-mail to a second party, the e-mail message comprising a recommendation for the second marketable entity and a URL link to a Web site. . . .”



Art Unit: 3622

Capiel (col. 1, ll. 55-60) shows elements that suggest tracking the email recipient's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

Capiel proposes email and URL forwarding modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Capiel with the teachings of Ng because such combination would have provided means for "*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . .*" (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)) and because such combination would have provided a means "*to identify the audience and tailor the advertising to that audience.*" (See Capiel (col. 1, ll. 22-24)).

As per claims 47-49, Ng in view of Morton and further in view of Capiel shows the method of claim 43 and subsequent claims depending from claim 43.

Ng (the ABSTRACT; FIG. 3 through FIG. 10; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-35; i.e., whole document) shows elements that suggest the elements and limitations of claims 47-49.

Art Unit: 3622

Ng lacks an explicit recitation of the elements and limitations of claims 47-49, even though Ng suggests same; however,

Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) in view of Capiel (the ABSTRACT; col. 1, ll. 55-60; col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 1; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that reasonably suggest the elements and limitations of claims 47-49.

Morton in view of Capiel propose email, reward and URL link modifications that would have applied to the system of Ng. It would have been obvious to a person of ordinary skill in the art the time of the invention to combine the disclosure of Morton with the teachings of Ng because such combination would have provided means for “*computer-assisted electronic commerce (e-commerce) . . . rewards programs. . .*” (see Ng (col. 1, ll. 5-15)) and because such combination would have provided a “viral marketing system in connection with an information service. . .” (See Morton (col. 10, ll. 12-20)) and because such combination would have provided a means “*to identify the audience and tailor the advertising to that audience.*” (See Capiel (col. 1, ll. 22-24)).

## RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment B, paper#11, filed 11/28/2003) have been fully considered but they are not persuasive for the following reasons:

Art Unit: 3622

Applicant's arguments are moot based on new grounds of rejection introduced by the Examiner in the instant Office action (Third Action Rejection, paper#12).

Furthermore, Applicant's submission of brochures as part of Amendment B (paper#11) is entered but not considered because said brochures are neither submitted in an Information Disclosure Statement format using USPTO Form 1449 nor submitted with and discussed in a 37 CFR 1.132 Affidavit.

### **CONCLUSION**

5. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

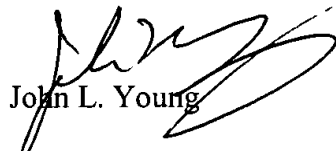
Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young  
Primary Patent Examiner

February 4, 2004